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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/129,675 08/05/98 HARARI

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EXAMINER

TRAN, A

ART UNIT

PAPER NUMBER

2824

DATE MAILED:

07/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/129,675

Applicant(s)
ELIYAHOU HARARI et al.

Examiner
Andrew Q. Tran

Art Unit
2824



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 19, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-111 is/are pending in the application.
- 4a) Of the above, claim(s) 92-111 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 5, 8, 10 20) ☐ Other:

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Applicant's election of invention of Group I, corresponding to claims 63-91, in Paper No. 14, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 92-111 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 14.

Claims 63-91 of this application has been copied from U.S. Patent No. 5,657,270 to Ohuchi et al. for the purpose of an interference.

Applicant has failed to specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application.

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application. See 37 CFR 1.607(a)(5). THE PROVISIONS OF 37 CFR 1.136 DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

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This application also fails to comply with 37 CFR 1.607(a)(4) in which the Applicant has failed to identify which claims pending in the instant application correspond to and which claims do not correspond to the proposed count, and to provide an explanation why of such identification.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested :

--Flash EEPROM system with cell-by-cell programming verification--.

The abstract of the disclosure is objected to because :

The instant abstract fails to summarize the technical disclosure of the subject matter being disclosed and claimed in the application.

Correction is required. See MPEP § 608.01(b).

The drawings are objected to because :

In Figure 1A, circuit block 31 should be relabeled as --Memory Controller--.

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In Figure 1B, circuit block 31 should be relabeled as --Memory Controller Chip--; and circuit block 40 should be relabeled as --Interface Circuit--.

In Figure 2, circuit block 31 should be relabeled as --Memory Controller--.

In Figure 3A, circuit block 233 should be relabeled as --Address Decoder--.

In Figure 3B, signal line 235 should be relabeled as --From Address Decoder--; and signal line 237 should be relabeled as --Clr Erase En--.

In Figure 6, "Controller 31" should be relabeled as --Memory Controller 31--; circuit block 33 should be relabeled as --Memory Device--; and circuit block 515 should be relabeled as --Rec & S/P--.

In Figure 7, "Controller 31" should be relabeled as --Memory Controller 31--; circuit block 33 should be relabeled as --Memory Device--; and circuit block 603 should be relabeled as --Intf In-
-.

Correction is required.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by

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a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 63-91 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-34 of U.S. Patent No. 5,172,338 to Mehrotra et al. (hereinafter referred to as Mehrotra et al. '338). Although the conflicting claims are not identical, they are not patentably distinct from each other because the respective claims presented in the instant application and that of Mehrotra et al. '338 recite substantially the same subject matter. That is, a non-volatile semiconductor memory device with supporting circuitry for programming and verifying memory cells. This is also admitted in Preliminary Amendment A filed August 05, 1998, page 28, lines 3-6.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 63-91 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Applicant has failed to provide clear, concise and adequate support in the specification for claims 63-91.

Claims 63-91 of this application have been copied by the applicant from U. S. Patent No. 5,657,270 to Ohuchi et al. These claims are not patentable to the applicant because of the rejections set forth above.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claims be patentable to the applicant subject to a judgement in the interference.

Papers related to this application may be submitted to Technology Center 2800, Group 2810 by facsimile transmission.

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Papers should be faxed to Group 2810 via the Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (October 19, 1988). The Fax Center number is (703) 308-7722 or (703) 308-7724.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Q. Tran whose telephone number is (703) 305-3495.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Andrew Q. Tran
July 26, 2001



ANDREW Q. TRAN
PRIMARY EXAMINER